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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,605

09/15/2003

Mickey Roemer

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,605

Applicant(s)

ROEMER ET AL.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 31-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not disclose a "new random order" as now called for in the claims.

The only mention "random" is on pg. 12, ln. 13. Here it recites;

"In the game scenario of Fig. 6, the player cannot select all of the game pieces 12 from the grid 14 in the third selection period due to their random placement as non-matching adjacent game pieces after the consolidation of the second shuffle."

This is not considered to be adequate support for the amendments made. Here it is not considered from the application as filed that applicant intended "shuffling" to include a "new random order" as now is being claimed. See e.g., Scarring Corp. v. Megan, Inc., 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000).

Claim Rejections - 35 USC § 103

Claims 1- 59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monte Carlo in view of Kelly 5,882,258 as set forth in the previous office action and further in view of Same Game as set forth in the previous office action;

Claim 1 has now been amended to include a pair "and three or more adjacent game pieces". A popular electronic version of Monte Carlo is Same

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Game or Jawbreaker. In this game a player can select two or more pieces. To have allowed a persons to select three adjacent pieces in Monte Carlo would have been obvious in order to allow a player to remove more pieces during each turn.

With respect to claims 31 and 61, in Monte Carlo the cards are moved up to fill the spaces of the removed cards and not replaced as stated by applicant. This is considered to meet the limitations of "shuffling" as called for in the claims.

As to claim 60, the specification merely states that "deactivation...does not necessarily result in the removal" but is most certainly could. The plain meaning of deactivate is to make inactive or ineffective. As such the examiners interpretation that removing cards as shown by Monte Carlo meets this limitation by now making the cards inactive is considered fair.

Applicant's arguments filed 7/11/07 have been fully considered but they are not persuasive.

Examiner does not agree that the limitations added to the claims that recites the game pieces to be "in a new random order" to distinguish over the art. Common definition of "random", "a haphazard course

— **at random**

: without definite aim, direction, rule, or method <subjects chosen *at random*>

does not help define the scope. Nor does the specification appear to lend any specific or special meaning to this term. In fact, the only mention "random" is on pg. 12, ln. 13. At best, the shuffling as disclosed needs only bring about a "consolidated grouping" (pg. 12, ln. 9) of pieces. Where the scope of shuffling and randomly ordering are, from the specification, taken to mean forming a "consolidated grouping", such is considered fairly taught by the prior art. Here the prior art shows most broadly, the movement of the pieces to fill the spaces in Monte Carlo and Jawbreaker can be considered to cause a "new random order" and forming a consolidated grouping. From pg. 5 of applicant's specification, shuffling "further includes shuffling any non-selected

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game pieces remaining within the game grid into a consolidated grouping, after all matching adjacent game pieces that have been perceived by a 15 player have been selected and removed". Clearly the steps of moving the pieces in Monte Carlo and Jawbreaker to down to fill in the spaces of any removed cards meet the steps of "shuffling" or rearranging the cards. On pg. 12 of the specification, "the shuffling process consolidates the remaining game pieces into a consolidated, contiguous arrangement that creates new adjacent game piece positions." Clearly Monte Carlo and Jawbreaker again meet this definition of "shuffling" as set forth in the specification as they move pieces down to fill the spaces of any removed cards. Nothing in the specification supports applicants assertion that shuffling is an "act of mixing cards haphazardly" or supports the limitation of a "new random order (bottom pg. 10 of remarks).

Even considering applicant's supplied definition of shuffle, "to push or move about, back and forth or from one place to another" is consistent with what is shown in the prior art in which the pieces are "moved about from one place to another" as they move to fill the spaces of the removed pieces.

With respect to the steps shown in getting from applicants fig. 3 to fig. 4. Such is an embodiment of the "condolidation" process of the remaining pieces to create new adjacent game pieces. There is nothing explicit that this process is "random".

Conclusion

Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive as set forth in the above grounds for rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM M. PIERCE
PRIMARY EXAMINER**